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| 10/054,436 | 01/18/2002 | George R. Walgrove III | 10432/59 | 5449 |
| 1333 | 7590 | 11/02/2005 | EXAMINER | |
| BETH READ PATENT LEGAL STAFF EASTMAN KODAK COMPANY 343 STATE STREET ROCHESTER, NY 14650-2201 | | | MILIA, MARK R | |
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| | | | 2622 | |

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/054,436

Applicant(s)

WALGROVE ET AL.

Examiner

Mark R. Milia

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>5/22/03</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: In Fig. 2, reference character "204". Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "said computer" in the last limitation. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 6, 13, 16, 18-22, 24, 29, and 30 rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6345168 to Pitts.

Regarding claims 1 and 20, Pitts discloses a printing apparatus having a detach charging system, comprising: a processor (see Fig. 1 "30"), and a detach charger operatively connected to said processor (see Fig. 1 "16", column 3 lines 1-3 and 10-12, and column 4 lines 29-35), wherein a programmed signal from said computer enables or disables said detach charger in response to a sheet weight of a sheet of paper fed into said printing apparatus (see column 4 lines 29-35 and 48-65, reference shows that

a DC bias, which controls the detack charging system, can be varied depending on the weight of a sheet of paper by a control system, which is analogous to the claim limitation and is therefore anticipated by the reference).

Regarding claim 6, Pitts discloses a printing machine having a detack charging system, comprising: a computer (see Fig. 1 "30", a computer by definition is anything that can compute and therefore the control system of the reference is a computer as it controls the transfer and detack corotrons), and a detack charger operatively connected to said computer (see Fig. 1 "16", column 3 lines 1-3 and 10-12, and column 4 lines 29-35), wherein a programmed signal from said computer enables or disables said detack charger in response to an attribute of a sheet of paper fed into said printing machine (see column 4 lines 29-35 and 48-65, reference shows that a DC bias, which controls the detack charging system, can be varied depending on the weight of a sheet of paper by a control system, which is analogous to the claim limitation and is therefore anticipated by the reference).

Regarding claim 13, Pitts discloses a method of detack charging in an image-forming machine, comprising: receiving a sheet a paper from a feeder (see Fig. 1 "12" and column 2 lines 55-58), said sheet of paper having a sheet weight (see column 4 lines 48-55, it is inherent that every sheet of paper has an associated weight), configuring an interface to receive a sheet weight limit (see column 4 lines 37-65, reference shows a user interface "32" that can be used to input paper weights related to a plurality of paper supply trays), generating an enable signal from a central processing unit (CPU) (see Fig. 1 "30") when said sheet weight is less than or equal to said sheet

weight limit and enabling a detack charger (see column 4 lines 29-65, reference states that lighter papers benefit from the variation in DC bias, which is enabling of a detack charger, reference also states that a user can input the weights of different stocks in different paper supplies and when the sheet is fed to the system the weight would be determined and mapped to an initial bias voltage which would in turn affect the behavior of the bias voltage during transfer dependent on the weight of the paper), and generating a disable signal from said CPU when said sheet weight is greater than said sheet weight limit and disabling said detack charger (see column 4 lines 29-65, reference states that heavier paper do not require a variation in DC bias, which is a disabling of a detack charger).

Regarding claim 29, Pitts discloses a method of detack charging in an image-forming machine, comprising: receiving a receiver sheet from a feeder (see Fig. 1 "12" and column 2 lines 55-58), said receiver sheet having a sheet weight (see column 4 lines 48-55, it is inherent that every sheet of paper has an associated weight), configuring an interface to receive a sheet weight limit (see column 4 lines 37-65, reference shows a user interface "32" that can be used to input paper weights related to a plurality of paper supply trays), and controlling said detack charger in response to a programmed signal from a central processing unit (CPU) based on said sheet weight limit (see column 4 lines 29-35 and 48-65, reference shows that a DC bias, which controls the detack charging system, can be varied depending on the weight of a sheet of paper by a control system, which is analogous to the claim limitation and is therefore anticipated by the reference).

Regarding claim 16, Pitts discloses the system discussed in claim 13, and further discloses connecting said CPU to said detach charger for receiving an enabled and disable signal (see Fig. 1 and column 4 lines 29-65).

Regarding claim 18, Pitts discloses the system discussed in claim 13, and further discloses configuring said interface to enable said detach charger for a specific sheet of paper in a specific feeder (see Fig. 1 and column 4 lines 29-65).

Regarding claim 19, Pitts discloses the system discussed in claim 13, and further discloses configuring said interface to enable said detach charger for all sheets of paper in a specific feeder (see Fig. 1 and column 4 lines 29-65).

Regarding claim 21, Pitts discloses the system discussed in claim 20, and further discloses wherein said receiver sheet is a sheet of paper (see column 2 lines 55-58 and column 4 lines 48-55).

Regarding claim 22, Pitts discloses the system discussed in claim 20, and further discloses wherein said receiver sheet is a transparency (see column 4 lines 61-65).

Regarding claim 24, Pitts discloses the system discussed in claim 20, and further discloses wherein said programmed signal from said processor, comprises a signal to enable or disable said detach charger (see column 3 line 61-column 4 line 35).

Regarding claim 30, Pitts discloses the system discussed in claim 29, and further discloses generating an enable signal from said CPU when said sheet weight is less than or equal to said sheet weight limit and enabling said detach charger (see column 4 lines 29-65), and generating a disable signal from said CPU when said sheet weight is

greater than said sheet weight limit and disabling said detach charger (see column 4 lines 29-65).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pitts in view of U.S. Patent No. 6504556 to Myers.

Regarding claim 11, Pitts discloses a printing machine having a detach charging system, comprising: a feeder to store sheets of paper, said sheets of paper comprising at least one sheet having a sheet weight (see Fig. 1 "12", column 2 lines 55-60, and column 4 lines 48-55, it is inherent that every sheet of paper has an associated weight), an interface having an input device, said interface configured for receiving a sheet weight limit (see Fig. 1 "32" and column 4 lines 29-65), allowing a user to selectively detach said at least one sheet (see column 4 lines 29-65), and a marking engine comprising a central processing unit (CPU) (see Fig. 1 "10" and "30"), a detach charger (see Fig. 1 "16"), said marking engine operatively connected to receive at least one sheet from said feeder (see Fig. 1 and column 2 lines 55-64), said CPU operatively connected to receive said sheet weight limit from said interface, and said detach

charger operatively connected to receive a first and a second signal from said CPU (see column 3 line 61-column 4 line 65), where said CPU provides said first signal when said sheet weight of said at least one sheet is less than or equal to said inputted sheet weight limit, and said detack charger is enabled in response to said first signal (see column 4 lines 29-65, reference states that lighter papers benefit from the variation in DC bias, which is enabling of a detack charger, reference also states that a user can input the weights of different stocks in different paper supplies and when the sheet is fed to the system the weight would be determined and mapped to an initial bias voltage which would in turn affect the behavior of the bias voltage during transfer dependent on the weight of the paper), and where said CPU provides said second signal when said sheet weight of said at least one sheet is greater than said inputted sheet weight limit, and said detack charger is disabled in response to said first signal (see column 4 lines 29-65, reference states that heavier paper do not require a variation in DC bias, which is a disabling of a detack charger).

Pitts does not disclose expressly an interface having a display, said interface further configured to access a menu system having a catalog of sheet attributes of said at least one sheet.

Myers discloses an interface having an input device and a display, said interface configured for receiving a sheet weight limit, said interface further configured to access a menu system having a catalog of sheet attributes of said at least one sheet, (see Figs. 4-6 and column 4 lines 1-60), and a marking engine comprising a central processing unit (CPU), having a memory to store said sheet weight limit and a detack charger, said

marking engine operatively connected to receive at least one sheet from said feeder, said CPU operatively connected to receive said sheet weight limit from said interface, and said detack charger operatively connected to receive a first and a second signal from said CPU (see Figs. 4-6 and 9, column 2 lines 6-34, column 4 line 39-column 5 line 15, and column 7 lines 40-48 and 53-54).

Regarding claim 12, Pitts discloses a method of detack charging in an image-forming machine, comprising receiving a sheet a paper from a feeder (see Fig. 1 and column 2 lines 55-58), said sheet of paper having a sheet weight (see column 4 lines 48-55, it is inherent that every sheet of paper has an associated weight), configuring an interface to receive a sheet weight limit (see column 4 lines 37-65), storing said sheet weight limit in a memory of a central processing unit (CPU) (see column 4 lines 37-65), allowing a user to selectively detack said sheet of paper (see column 4 lines 29-65), connecting said CPU to a detack charger for receiving an enable and disable signal (see Fig. 1 and column 4 lines 29-65), generating said enable signal from said CPU when said sheet weight is less than or equal to said sheet weight limit and enabling said detack charger (see column 4 lines 29-65, reference states that lighter papers benefit from the variation in DC bias, which is enabling of a detack charger, reference also states that a user can input the weights of different stocks in different paper supplies and when the sheet is fed to the system the weight would be determined and mapped to an initial bias voltage which would in turn affect the behavior of the bias voltage during transfer dependent on the weight of the paper), and generating said disable signal from said CPU when said sheet weight is greater than said sheet weight limit and disabling

said detach charger (see column 4 lines 29-65, reference states that heavier paper do not require a variation in DC bias, which is a disabling of a detach charger).

Pitts does not expressly disclose configuring said interface to access a menu system, said menu system having a catalog of sheet attributes of said sheet of paper.

Myers discloses configuring said interface to access a menu system, said menu system having a catalog of sheet attributes of said sheet of paper (see Figs. 4-6 and column 4 lines 1-60).

Pitts & Myers are combinable because they are from the same field of endeavor, utilization of paper stock attributes to effectively transfer and detach the paper stock.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the use of a user interface with a display to configure a plurality of paper stock attributes and to store such a configuration in memory to be utilized by the printing system with the system of Pitts.

The suggestion/motivation for doing so would have been to provide enhanced efficiency through designation of paper stock attributes to increase the speed at which transferring and imaging can take place.

Therefore, it would have been obvious to combine Myers with Pitts to obtain the invention as specified in claims 11 and 12.

8. Claims 2-5, 7-10, 14, 15, 17, and 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pitts as applied to claims 1, 6, 13, and 20 above, and further in view of Myers.

Regarding claims 2, 7, and 25, Pitts discloses a feeder to store sheets of paper, said sheets of paper comprising at least one sheet having a sheet weight (see Fig. 1 "12" and column 2 lines 55-60, and column 4 lines 48-55), and an interface having an input device (see Fig. 1 "32") and a display, said interface configured for receiving an inputted sheet weight limit (see column 4 lines 29-65), said interface further configured to access a menu system having a catalog of sheet attributes of said at least one sheet, allowing a user to selectively enable said detach charger for said at least one sheet (see column 4 lines 29-65).

Pitts does not disclose expressly an interface having a display, said interface further configured to access a menu system having a catalog of sheet attributes of said at least one sheet.

Myers discloses a feeder to store sheets of paper, said sheets of paper comprising at least one sheet having a sheet weight (see Figs. 1, 2, 5, 6, and 9), and an interface having an input device and a display (see Fig. 9), said interface configured for receiving an inputted sheet weight limit, said interface further configured to access a menu system having a catalog of sheet attributes of said at least one sheet (see Figs. 4-6 and column 4 lines 1-60).

Regarding claims 3, 8, and 26, Pitts discloses a marking engine comprising a central processing unit (CPU) having a memory to store said sheet weight limit (see Fig. 1 "10" and "30"), said marking engine operatively connected to said feeder to receive said at least one sheet from said feeder (see Fig. 1 "12"), said CPU operatively connected to said interface to receive said sheet weight limit from said interface (see

Fig. 1 "30" and column 4 lines 29-65), and said detack charger operatively connected to receive said programmed signal from said CPU (see Fig. 1 "16" and column 4 lines 29-65).

Regarding claims 4 and 27, Pitts discloses wherein said programmed signal enables said detack charger when said sheet weight of said at least one sheet is less than or equal to said sheet weight limit (see column 4 lines 29-65).

Regarding claims 5 and 28, Pitts discloses wherein said programmed signal disables said detack charger when said sheet weight of said at least one sheet is greater than said sheet weight limit (see column 4 lines 29-65).

Regarding claim 9, Pitts discloses wherein said programmed signal enables said detack charger when said inputted attribute matches a "detack" attribute of said at least one sheet (see column 4 line 15-column 5 line 15).

Regarding claim 10, Pitts discloses wherein said programmed signal disables said detack charger when said inputted attribute matches a "no detack" attribute of said at least one sheet (see column 4 line 15-column 5 line 15).

Regarding claim 14, Myers discloses storing said sheet weight limit in a memory of said CPU (see Fig. 6 and column 4 lines 1-60).

Regarding claim 15, Myers discloses configuring said interface to access a menu system, said menu system having a catalog of sheet attributes of said sheet of paper (see Figs. 4-6 and column 4 lines 1-60).

Regarding claim 17, Pitts discloses configuring said interface to enable said detack charger for a specific sheet of paper (see column 4 lines 29-65).

Pitts & Myers are combinable because they are from the same field of endeavor, utilization of paper stock attributes to effectively transfer and detack the paper stock.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the use of a user interface with a display to configure a plurality of paper stock attributes and to store such a configuration in memory to be utilized by the printing system with the system of Pitts.

The suggestion/motivation for doing so would have been to provide enhanced efficiency through designation of paper stock attributes to increase the speed at which transferring and imaging can take place.

Therefore, it would have been obvious to combine Myers with Pitts to obtain the invention as specified in claims 2-5, 7-10, 14, 15, 17, and 25-28.

9. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pitts as applied to claim 20 above, and further in view of U.S. Patent No. 5257097 to Pineau et al. as cited on the Information Disclosure Statement dated 5/22/03.

Pitts discloses wherein sheets to be printed upon can be coated paper of transparencies (see column 4 lines 61-65).

Pitts does not disclose expressly wherein said receiver sheet is a tabloid.

Pineau discloses wherein said receiver sheet is a tabloid (see column 2 lines 55-56).

Pitts & Pineau are combinable because they are from the same field of endeavor, printing documents.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the use of a tabloid as a paper stock option with the system of Pitts.

The suggestion/motivation for doing so would have been to provide more options for paper stock, (as mentioned by Pitts in column 4 lines 61-65) and increased efficiency for determining a particular type of stock.

Therefore, it would have been obvious to combine Pineau with Pitts to obtain the invention as specified in claim 23.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. To further show the state of the art refer to the attached Notice of References Cited.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (571) 272-7408. The examiner can normally be reached M-F 8:00am-4:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached at (571) 272-7402. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark R. Milia
Examiner
Art Unit 2622

MRM


EDWARD COLES
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